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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,420	10/01/2003	Myriam Kauffmann	243276US26	5165

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EXAMINER

HUYNH, KHOA D

ART UNIT PAPER NUMBER

3751

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/674,420

Applicant(s)

KAUFFMANN ET AL.

Examiner

Khoa D. Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 4,6-13,17,19-24,28,29,36-38,49,50 and 53-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,14-16,18,25-27,30-35,39-48,51,52 and 56-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second substance is adjacent the first end as recited in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5, 14-16, 18, 25-27, 30-34, 40-48, 51, 52 and 57-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what structural limitation applicant intends to cover when claim 1 calls for "at least one tube having a first end" on line 2 and "a first end of the inside space of the tube is defined by the plug". Such recitations render the claim indefinite since, as understood, the first end of the tube and the first end of the inside space of the tube are essentially the same end. Since claim 1 does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable. Claims 2, 3, 5, 14-16, 18, 25-27, 30-34, 40-48, 51, 52 and 57-63 depend on claim 1 and are likewise indefinite.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 14-16, 18, 25-27, 30-34, 40-48, 51, 52 and 57-63, as presently and best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aiken (3757782) in view of Tsao (5702035).

Regarding claim 1, the Aiken reference discloses an applicator (Fig. 3). The applicator includes a tube (12) having a first end, a plug (16), a first substance (about 24) contained in an inside space of the tube. A first end of the inside space is defined by the plug (at 16 on the right side of Fig. 3). The applicator further includes a second substance different from the first substance (col. 3, lines 30-35) and dissociated therefrom prior to use, and the second substance is being adjacent the first end (note: if applicant shows in Figure 2 of the instant application that (a) substance P1 is dissociated from substance P2 prior to use and contends that substance P1 is being adjacent the first end, then it is reasonable for the examiner to take the position that the second substance of the Aiken reference could also be construed as being adjacent to the first end).

The Aiken reference DIFFERS in that the plug is not specifically a liquid plug as claimed. Attention, however, is directed to the Tsao reference which discloses another applicator having a liquid plug (66) located at the tip end of the applicator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Aiken reference by employing a liquid plug in view of the teaching of Tsao. Such modification would be considered a mere choice of a preferred liquid plug or stopper on the basis of its suitability for the intended use especially since the use of liquid plug for an applicator is relatively known the applicator art (see US 6343717, US 2005/0053413, US 2004/0116824).

Regarding claims 2 and 3, the first and second substances are separated from each other by an extra component or plug (at 22). Even though the modified Aiken reference does not disclose that the extra plug is of a liquid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Aiken reference by employing a liquid plug in view of the teaching of Tsao. Such modification would be considered a mere choice of a preferred liquid plug or stopper on the basis of its suitability for the intended use especially since the use of liquid plug for an applicator is relatively known in the applicator art (see US 6343717, US 2005/0053413, US 2004/0116824).

Regarding claim 5, the modified Aiken reference states that the first and second substances contain respective compounds that are incompatible (col. 3, lines 30-35).

Regarding claims 14-16, the applicator (12) also includes an applicator element which is a porous, cotton bud or tip (at 18 on the right side of Fig. 3).

Regarding claim 18, in use, the second substance obviously impregnates the applicator element (18).

Regarding claims 25 and 26, the Tsao reference discloses that the liquid plug (66) is a liquid silicone.

Regarding claims 27 and 30 (as best understood), as schematically shown in Figure 3 of Aiken, the inside space is defined at a second end (about 20 on the left side of Fig. 3) remote from the plug by a portion of the tube (the cotton tip on

the left side of Fig. 3) and that is obviously suitable for being deformed if so desired. Also, when the portion is deformed, the portion (the cotton tip on the left side of Fig. 3) is obviously capable being retained by the ends (the tapered portion of the cotton tip) of the portion.

Regarding claims 31 and 32, the modified Aiken reference DIFFERS in that it does not specifically include the volume of substance contained lies in the range of 0.01 mL to 5mL or 0.05 mL to 1mL as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such range for the volume of substance contained in the tube since discovering an optimum range of a result effective variable involves only routine skill in the art.

Regarding claim 33, the modified Aiken reference also discloses that the tube is transparent (Abstract, lines 4-5).

Regarding claim 34 (as best understood), as schematically shown in Figure 3, the first and second substances are unsuitable for being stored in contact with each other.

Regarding claims 40-46, even though the modified Aiken reference does not specifically disclose that the first and second substances are of a nail care, a hair care, a make-up or a sunless tanning product as claimed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modified the first and second substances of the Aiken applicator to be a nail care, a hair care, a make-up or a sunless tanning product. Such modification would be

considered a mere choice of a preferred health and beauty product on the basis of its suitability for the intended use.

Claim 47 recites limitations that are substantially similar to the limitations of claim 1 which has been rejected as discussed supra.

Regarding claim 48, as schematically shown in Figure 3, the plug is located between the first substance and an exterior of the applicator.

Regarding claims 51 and 52, the applicator includes a plurality of plugs (16, 22). The first plug (16) is located between the first substance and an exterior of the applicator, and the second plug (22) is disposed between the first substance and the second substance.

Claims 57-63 recite limitations that are substantially similar to the limitations of claims 40-46 which have been rejected as discussed supra.

6. Claims 35, 39 and 56, as presently and best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Aiken in view of Gurrera (5996780).

The modified Aiken reference DIFFERS in that it does not specifically include a packaging for the applicator as claimed. Attention, however, is directed to the Gurrera reference which discloses another applicator (13) including a packaging (15) in which the applicator is disposed prior to use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the modified Aiken reference by employing a packaging, in view of the teaching of Gurrera, in order to store and keep the



applicator in a sterile condition prior to use. The Gurrera reference further discloses a box (11) for holding the packaging.

***Response to Amendment***

7. Applicant's amendment, filed on 02/06/06, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

***Response to Arguments***

8. Applicant's arguments filed on 02/06/06 with respect to the pending claims have been fully considered. However, they are deemed not persuasive.

Applicant asserts that the Aiken reference does not teach the claimed feature of an applicator in which the second substance is adjacent the first end of a tube. See Remarks section, page 11. The examiner disagrees.

As stated in the above rejection, the Aiken reference discloses an applicator including a second substance different from the first substance. The second substance is dissociated therefrom prior to use, and the second substance is being adjacent the first end. It is reasonable for the examiner to take the position that the second substance of the Aiken reference could be construed as being adjacent to the first end of the tube because (a) applicant does not provide any limitation to specify the condition under which the second substance is adjacent to the first end of the tube and (b) applicant, as illustrated in Figure 2 of the instant application, shows that substance P1 is dissociated from substance P2 and being adjacent to the first end prior to use.

Applicant also asserts that the Tsao reference does not render obvious the above-discussed features since the Tsao reference discloses a tubular container containing a single product. See Remarks section, page 11. The examiner disagrees.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reasons why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In this case, for instance, Aiken does teach an applicator having substantially all claimed features except for the liquid plug as claimed. Tsao is applied herein for the teaching of using a liquid plug for an applicator. The examiner maintains that such modification, i.e. using a liquid plug for an applicator is well within one of ordinary skill art and is not convinced that the use of a liquid plug inside an applicator to hold and/or to separate different liquids rises to the level of patentability.

### **Conclusion**

9. Applicant's amendment necessitated the new grounds of rejection and objections presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

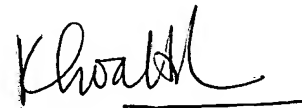
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Khoa D. Huynh', with a horizontal line underneath.

Khoa D. Huynh  
Primary Examiner  
Art Unit 3751

HK  
04/05/2006